

PATENT
Attorney Docket No. 08020.0013-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Hilmar WECHSEL) Group Art Unit: 3689
Application No.: 10/787,205) Examiner: NGUYEN, THUY-VI THI
Filed: February 27, 2004)
For: SYSTEMS AND METHODS FOR) Confirmation No.: 4680
MANAGING PRODUCT RETURNS)
USING RETURN)
AUTHORIZATION NUMBERS)

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed June 1, 2011, and further to Board Rule 41.37, Appellant presents this brief and enclose herewith the fee of \$540.00 required under 37 C.F.R. § 41.20(b)(2).

This Appeal Brief is being filed concurrently with a petition for an Extension of Time for 1 month, and the appropriate fee.

This Appeal responds to the Examiner's decision mailed March 1, 2011, rejection of claims 1-6, 9-36, and 40-47.

If any additional fees are required or if the enclosed payment is insufficient, Appellant requests that the required fees be charged to Deposit Account 06-0916.

TABLE OF CONTENTS

Real Party in Interest	4
Related Appeals and Interferences	5
Status of Claims	6
Status of Amendments	7
Summary Of Claimed Subject Matter	8
Independent Claim 1	8
Independent Claim 9	9
Independent Claim 13	10
Independent Claim 20	12
Independent Claim 21	13
Independent Claim 24	14
Independent Claim 31	15
Independent Claim 32	16
Independent Claim 40	17
Independent Claim 41	18
Grounds of Rejection to be Reviewed on Appeal	20
Argument	21
A. The Examiner disregards the claim limitation “when the quantity of the product associated with the return request [...]” because of an incorrect reading of M.P.E.P 2106.II.C	21
1. MPEP 2106.II.C does not exclude “conditional/optional” language from consideration	22
2. There is no basis in MPEP 2106.II.C for concluding that claimed features including the word “when” should be excluded from consideration	24
B. The Examiner’s contention that independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 are obvious in view of <i>Hauser</i> and <i>Bloom</i> is incorrect	26
1. The Examiner’s proposed combination of <i>Hauser</i> and <i>Bloom</i> fails to disclose at least the claimed “splitting the second record into a plurality of new records [...] when the quantity of the product associated with the return request included in the	

second record does not match the quantity of the product received at the warehouse."	26
2. The Examiner admits that the combination of <i>Hauser</i> and <i>Bloom</i> fails to disclose at least one claimed feature and provides only a conclusory statement that this feature is "obvious."	28
3. The Examiner's proposed addition of record recombination to <i>Bloom</i> would at least change the principle of operation of <i>Bloom</i> and render <i>Bloom</i> unsatisfactory for its intended purpose.....	31
4. The Examiner's fails to consider all of the claimed features in at least independent claims 9, 13, 20, 21, 24, 31, 32, and 41.	33
C. Dependent claims 2-6, 10-12, 14-19, 21-23, 25-30, 33-36, and 42-27.....	35
D. Conclusion	35
Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)	37
Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)	53
Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)	54

Real Party in Interest

SAP AG is the real party in interest.

Related Appeals and Interferences

There are currently no other appeals or interferences, of which appellant, appellant's legal representative, or assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 7, 8, and 37-39 have been cancelled without prejudice or disclaimer. All of pending claims 1-9, 36, and 40-47 were finally rejected in the Final Office Action mailed April 5, 2011 (hereinafter "the Final Office Action"). The rejections applied to those claims are at issue in this appeal. The rejected claims involved in this appeal are set forth in the attached Claims Appendix. No claims have been allowed or objected to.

Status of Amendments

No amendments have been filed subsequent to the final rejection of claims 1-6, 9-36 and 40-47 in the Final Office Action mailed May 1, 2011.

Summary Of Claimed Subject Matter

Independent Claim 1

As fully supported in Appellant's Specification, claim 1 recites a computer-implemented method for managing a return of a product (see, e.g., method shown in Fig. 2). The method comprises the following steps, performed by a computer (Fig. 2). The method includes the step of receiving at a first computer-implemented management system a return request for the product, wherein the return request is for a quantity of the product greater than one (see Fig. 2, item 201 and page 10, line 3). The method includes the step of determining whether the return request is authorized (Fig. 2, element 203). The method includes the steps of creating a first record in the first system in response to a determination that the return request is authorized, the first record including a return authorization number (RAN) and issuing, from the first system, the RAN associated with the return request (Fig. 2, element 207). The method includes the steps of creating a second record in a second computer-implemented management system in response to receiving the RAN from the first system, the second record being a warehouse request comprising a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the product associated with the return request (page 5, lines 6-7). The method includes the step of searching a database of the second system for the pending delivery item using a RAN associated with a product received at a warehouse (page 14, lines 18-22). The method includes the steps of determining, based on searching the database, if the quantity of the product associated with the return request included in the second record matches a quantity of

the product received at the warehouse (page 14, lines 18-24). The method includes the step of splitting the second record into a plurality of new records including the RAN and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method includes the step of re-combining the plurality of new records into the second record, when the quantity of the product associated with return request included in the second record matches the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 6-10). The method includes the step of updating the second record to reflect that the quantity of the product associated with the return request included in the second record matches the quantity of the product received at the warehouse (page 4, lines 1-4).

Independent Claim 9

As fully supported in Appellant's Specification, claim 9 recites a computer-implemented method for managing a product return (see, e.g., method shown in Fig. 2). The method includes the step of authorizing, using a first computer-implemented management system, a request from a customer to return a product, wherein the request from a customer is for a quantity of the product greater than one (see Fig. 2, item 201 and page 10, line 3). The method includes the step of creating at least one record in each of a plurality of second computer-implemented management systems of a supplier when the request for the product return is authorized, the at least one record being a warehouse request comprising a pending delivery item, the pending delivery

item including a unique identifier, a product type, and the quantity of the product associated with the request (Fig. 2, element 207). The method includes the step of assigning the unique identifier to the product return (page 3, lines 17-18). The method includes the step of associating the unique identifier with each record corresponding the product to be returned (page 3, lines 16-19). The method includes the step of searching a database associated with the second systems for the pending delivery item using a unique identifier associated with a product received at a warehouse (page 3, lines 20-23). The method includes the step of determining, based on searching the database, if the quantity of the product associated with the request included in the at least one record matches a quantity of the product received at the warehouse (page 12, lines 5-7). The method includes the step of splitting the at least one record in each of the second systems into a plurality of new records including the unique identifier and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the request included in the at least one record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method includes the step of exchanging information regarding the product return between the second systems utilizing the unique identifier (Fig. 6 and page 23, lines 20-23).

Independent Claim 13

As fully supported in Appellant's Specification, claim 13 recites computer-implemented method for managing a product return (see, e.g., method shown in Fig. 2). The method includes the step of assigning at least one return authorization number

(RAN) to the product return, wherein the product return is for a quantity of the product greater than one (see Fig. 2, item 201 and page 10, line 3). The method includes the step of creating, in a first database of a supplier, a return authorization record for the product return, the return authorization record comprising the RAN (page 4, lines 5-9). The method includes the step of creating, in a second database of the supplier, a warehouse record for the product return, the warehouse record comprising a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the product associated with the product return (page 4, lines 9-11). The method includes the step of searching the second database using a RAN associated with a product received at a warehouse (page 23, lines 8-10). The method includes the step of determining, based on searching the second database, if the quantity of the product associated with the product return included in the warehouse record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The method includes the step of splitting the warehouse record into a plurality of new records including the RAN and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the product return included in the warehouse record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method includes the step of updating the return authorization record and the warehouse record to include information associated with the RAN (page 4, lines 1-4).

Independent Claim 20

As fully supported in Appellant's Specification, claim 20 recites a computer-implemented method for managing a product return (see, e.g., method shown in Fig. 2). indexing a first record in a first database of a supplier for a product return using at least one unique identifier, wherein the product return is for a quantity of the product greater than one (page 4, lines 14-16). The method includes the step of creating a second record for the product return in a second database of the supplier, the second record comprising a pending delivery item, the pending delivery item including the at least one unique identifier, a product type, and the quantity of the product associated with the product return (page 5, lines 5-10). The method includes the step of searching the second database using a unique identifier associated with a product received at a warehouse (page 23, lines 8-10). The method includes the step of determining, based on searching the second database, if the quantity of the product associated with the product return included in the second record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The method includes the step of splitting the second record in the second database into a plurality of new records including the at least one unique identifier and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the product return included in the second record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method includes the step of exchanging, between the first and second databases, information related to the product return, wherein each item of exchanged information is identified by the at least one unique identifier (Fig. 6 and page 23, lines 20-23).

Independent Claim 21

As fully supported in Appellant's Specification, claim 21 recites a computer-readable medium including a memory containing instructions for carrying out a method for managing a product return (page 4, lines 13-14). The method comprises creating a first record in a customer relationship management (CRM) system of a supplier for a product return using at least one return authorization number (RAN), wherein the product return is for a quantity of the product greater than one (see Fig. 2, item 201 and page 10, line 3). The method comprises creating a second record for the product return in a warehouse management (WM) system of the supplier using the return authorization number, the second record comprising a pending delivery item, the pending delivery item including at least one RAN, a product type, and the quantity of the product associated with the product return (page 5, lines 6-7). The method comprises searching a database associated with WM system for the pending delivery item using a RAN associated with a product received at a warehouse (page 14, lines 18-22). The method comprises determining, based on searching the database, if the quantity of the product associated with the product return included in the second record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The method comprises splitting the second record into a plurality of new records including the at least one RAN and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the product return in the second record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method comprises exchanging between the management systems information related to the product return, wherein each item of

exchanged information is identified by the return authorization number (Fig. 6 and page 23, lines 20-23).

Independent Claim 24

As fully supported in Appellant's Specification, claim 24 recites a computer-readable medium including a memory containing instructions for carrying out a method (page 4, lines 13-14). The method comprises assigning a return authorization number (RAN) to an approved product return, wherein the product return is for a quantity of the product greater than one (see Fig. 2, item 201 and page 10, line 3). The method comprises creating, in a first database of a supplier, a return authorization record for the approved product return, the return authorization record comprising the RAN (Fig. 2, element 207). The method comprises creating, in a second database of the supplier, a pending delivery record comprising a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the product associated with the product return (page 5, lines 6-7). The method comprises searching the second database for the pending delivery item using a RAN associated with a product received at a warehouse (page 14, lines 18-22). The method comprises determining, based on searching the second database, if the quantity of the product associated with the product return included in the pending delivery record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The method comprises splitting the pending delivery record into a plurality of new records including the RAN and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the product return included in

the delivery record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method comprises updating the return authorization and the pending delivery records using the RAN (page 4, lines 9-11).

Independent Claim 31

As fully supported in Appellant's Specification, claim 31 recites a computer-readable medium including a memory containing instructions for carrying out a method for managing a product return (page 4, lines 13-14). The method comprises authorizing using a first computer-implemented management system a request from a customer to return a product, wherein the request is for a quantity of the product greater than one (see Fig. 2, item 201 and page 10, line 3). The method comprises creating at least one record in each of a plurality of second management systems of a supplier for handling the product return, the at least one record being a warehouse request comprising a pending delivery item, the pending delivery item including a unique identifier, a product type, and the quantity of the product associated with the request (page 5, lines 6-7). The method comprises assigning the unique identifier to the product return, associating the unique identifier with each record corresponding to the product to be returned and searching a database associated with the second systems for the pending delivery item using a unique identifier associated with a product received at a warehouse (page 14, lines 18-22). The method comprises determining, based on searching the database, if the quantity of the product associated with the request included in the at least one record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The method comprises splitting the at least one record in into a plurality of new

records including the unique identifier and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the product associated with the request included in the at least one record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The method comprises exchanging information regarding the product return between the second systems utilizing the unique identifier (Fig. 6 and page 23, lines 20-23).

Independent Claim 32

As fully supported in Appellant's Specification, claim 32 recites a system for managing a return of a product (page 3, lines 7-8). The system comprises a first computer comprising a first database of a supplier configured to receive a return request for the product, and to generate a first record comprising a return authorization number (RAN) for the product if the return request is authorized, wherein a quantity of the returned item is greater than one (see Fig. 2, item 201 and page 10, line 3). The system comprises a second computer comprising a second database of the supplier, in communication with the first database, configured to create a second record corresponding to the return, the second record comprising a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the returned item associated with the return request (page 5, lines 6-7). The second computer is configured to determine, based on searching the second database, if the quantity of the returned item associated with the return request included in the second record matches a quantity of the product received at the warehouse (page 14, lines 18-24), and configured to split the second record into a plurality of new records including

the RAN and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the returned item associated with the return request included in the second record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10). The first and second database are each configured to exchange information regarding the return utilizing the RAN (Fig. 6 and page 23, lines 20-23).

Independent Claim 40

As fully supported in Appellant's Specification, claim 40 recites a system for managing a product return comprising a processor, and a memory comprising instructions which, when executed by the processor cause the system to receive a return authorization number (RAN) and to create at least one record corresponding to a product return, wherein each record corresponding to the return item comprises a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the product return (page 3, lines 7-8 and page 5, lines 6-7). The memory comprises instructions cause the system to search a database for the pending delivery item using a RAN associated with a product received at a warehouse (page 14, lines 18-22). The memory comprises instructions cause the system to determine, based on a search of the database, if the quantity of the product associated with the product return included in the at least one record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The memory comprises instructions cause the system to split the at least one record corresponding to the product return into a plurality of new records including the RAN and having different statuses, wherein the different

statuses indicate return of a quantity of the product, when the quantity of the product return included in the at least one record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10).

Independent Claim 41

As fully supported in Appellant's Specification, claim 41 recites a system for managing a product return, the system comprises a first computer of a supplier (page 3, lines 7-8). The first computer comprising a user interface for receiving a return request from a customer, wherein a quantity of the return request is greater than one (see Fig. 2, item 201 and page 10, line 3). The first computer comprising a user interface for creating a first record comprising a return authorization number (RAN) and transmitting to the customer an authorization for a product return comprising the RAN (page 16, lines 7-9). The system comprises a second computer of the supplier, in communication with the first computer, configured to receive the RAN, create, upon receipt of the return authorization, a second record in a second database comprising a pending delivery item, the pending delivery item including the RAN, a product type, and the quantity of the return request (page 5, lines 6-7). The second computer is further configured to search a database associated with the second computer for the pending delivery item using a RAN associated with a product received at a warehouse (page 14, lines 18-22). The second computer is further configured to determine, based on a search of the database, if the quantity of the return request included in the second record matches a quantity of the product received at the warehouse (page 14, lines 18-24). The second computer is further configured to split the second record into a plurality of new records

including the RAN and having different statuses, wherein the different statuses indicate return of a quantity of the product, when the quantity of the return request included in the at least one record does not match the quantity of the product received at the warehouse (Fig. 6 and page 23, lines 1-10).

Grounds of Rejection to be Reviewed on Appeal

Claims 1-6, 9-36, and 40-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,536,659 to *Hauser* et al. ("Hauser") in view of U.S. Patent Application Publication No. 2002/0178074 to *Bloom* ("Bloom").

Argument

The Examiner must make several basic factual inquiries to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere*, require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

See *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Here the Final Office Action has at least failed to provide elements (1) and (2), determine the scope and content of the prior art and to ascertain differences between the instant application and the cited art. The rejection under 35 U.S.C. 103(a) rests on two contentions: A) certain aspects of the independent claims that are not found in the prior art may be disregarded and B) other aspects of the claims are obvious in view of *Hauser* and *Bloom*. Independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 are not obvious in view of the cited art at least because both of these contentions are incorrect.

A. The Examiner disregards the claim limitation “when the quality of the product associated with the return request [...]” because of an incorrect reading of M.P.E.P 2106.II.C.

On page 32 of the Final Office Action, the Examiner contends that, because of the use of the word “when,” the following claim feature of claim 1 is “conditional/optional” (emphasis added):

splitting the second record into a plurality of new records the plurality of new records including the RAN and having different statuses, when the

quantity of the product associated with the return request included in the second record does not match the quantity of the product received at the warehouse. (Emphasis added).

The Examiner further contends on pages 8 and 31-32 of the Final Office Action that, because the claim feature is allegedly “conditional/optional,” MPEP 2106.II.C provides that it “does not limit the scope of a claim or claim limitation” and, therefore, should be disregarded. The Examiner comes to the same conclusion regarding the similar features of independent claims 9, 13, 20, 21, 24, 31, 32, 40, and 41.¹ The Examiner is incorrect on both counts: 1) MPEP 2106.II.C does not exclude “conditional/optional” language from consideration and 2) there is no basis in MPEP 2106.II.C for disregarding claimed features because of the use of the word “when.”

1. MPEP 2106.II.C does not exclude “conditional/optional” language from consideration.

MPEP 2106.II.C does not exclude “conditional/optional” (emphasis added) subject matter from consideration. In fact, the phrase “conditional/optional” is not used anywhere in the MPEP. Moreover, the term “conditional” is not mentioned anywhere in section 2106 of the MPEP, much less in MPEP 2106.II.C. Rather, MPEP 2106.II.C excludes:

Language that **suggests or makes optional but does not require** steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (Emphasis added).

The Examiner concludes on page 32 of the Final Office Action that:

¹ See Final Office Action pages 16-18 for independent claim 9; Final Office Action pages 23-24 for independent claim 13; Final Office Action page 27 for independent claims 20, 21, and 24; and Final Office Action pages 28-29 for independent claims 31, 32, 40, and 41.